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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RABINDRANATH DUTTA,
KARTHIKEYAN RAMAMOORTHY,
and RICHARD SCOTT SCHWERDTFEGER

Appeal 2007-3355
Application 09/820,508
Technology Center 2100

Decided: February 7, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD, and ST. JOHN
COURTENAY III, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal a Final Rejection of claims 1, 2, 4-11, 13, 15-19, 21-23, 25-27, 33, and 34 under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

According to Appellants, they invented a method, system, and computer program product that parse a document for salient features and present a non-visual overview of the document using the salient features. (Spec. 5:3-8.)

Claim 1 is exemplary and is reproduced below:

1. A method in a data processing system for presenting content in a document, the method comprising the steps of:

parsing the document for one or more salient features that collectively provide an overview of the document;¹

initially presenting the document overview to a user in a manner other than visually, the presented overview comprising only the collective salient features and excluding any other portions of the document;² and

presenting a particular one of the other document portions to the user only in response to a request from the user for the particular portion.³

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kiraly et al.

US 6,564,186 B1 May 13, 2003

Claims 1, 2, 4-11, 18, and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiraly.

¹ Appellants refer to this step as step (1). (App. Br. 10.)

² Appellants refer to this step as step (2). (*Id.*)

³ Appellants refer to this step as step (3). (*Id.*)

Claims 13, 15-17, 19, 21-23, 33, and 34 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kiraly.

We affirm and enter a new ground of rejection.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Kiraly

1. Kiraly teaches a text-assistant software that generates audible speech for text in a *selected portion* of a document. (Col. 2, ll. 42-43 and Col. 8, ll. 14-19.) Kiraly teaches a text filter that filters out text that should not be read aloud. (Col. 14, ll. 49-51.)
2. Kiraly teaches that if the text-reader software determines that (a) all the words in the *selected portion* of the document have been read aloud or (b) the user has stopped the text-reader software, no other portions of the document are read. (Col. 11, ll. 4-9.) Otherwise, the text-reader software automatically selects a next section of the document (e.g. next word or next phrase) provided the next section is within the selected portion and the text-reader software is still active. (Col. 11, ll. 9-12.)

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie*

obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). “[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Id.* at 1313.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the

prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”). “If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103.” *KSR*, 127 S. Ct. at 1734.

ANALYSIS

Claim 1

The Examiner concludes that claim 1 is obvious over Kiraly. (Ans. 8-10 and 12-17.) Appellants allege that Kiraly does not teach the steps (1)-(3). (App. Br. 10 and 13-19 and Reply Br. 4-8.) In addition, Appellants allege that Kiraly cannot be modified to meet steps (1)-(3) because Kiraly requires presenting all words of a document, in sequential order, whereas presenting an overview “[f]requently, or most all of the time,” does not present every selected word in sequential order. (App. Br. 19-20 and Reply Br. 4.)

Step (1)

We begin our analysis by construing “salient features that collectively provide an overview of the document” of step (1). Appellants’ Specification

provides no explicit definition of “salient features” and “overview.”

Concerning those terms, Appellants’ Specification states:

present sufficient portions of content within a document to a visually impaired user so that the visually impaired user is able to obtain an overview of the document. . . . Salient features may include, for example, bold text, italicized text, underlined text, text in a selected color, and text having a certain font size and/or text having a certain position within the document, such as a title, heading, first sentence.

(Spec. 7:25-8:2.)

We find that the term “salient” sets a subjective standard and thus encompasses text that is interesting to a particular reader, provided the salient text provides an overview of a document. What is salient to one reader may not be salient to another reader. We broadly yet reasonably construe the claimed “salient features that collectively provide an overview of the document” to involve text of interest to the user, where the text describes the general subject matter of the document.

Next, we determine whether Kiraly teaches step (1). Step (1) requires parsing a document for text of interest to the user, where the text describes the general subject matter of the document. Kiraly teaches allowing a user to *select* portions of a document to be read aloud. (FF 1.) We find that selecting portions of a document meets the “parsing” of step (1). Moreover, the selected portion is of interest to a user because the user selected the text. When a document includes an overview section, such as a summary section of a patent application or even a title, such section provides a document

overview. Accordingly, Kiraly meets all requirements of step (1) by allowing a user to select an overview of a document.

Step (2)

Step (2) requires non-visually presenting the overview having salient features and no other portions of the document. We found *supra* with regard to step (1) that Kiraly teaches selecting an overview of salient features and the overview can be a subset of the entire document. Kiraly teaches selecting a *subset* of a document and generating audible *speech* representing text in a document. (FF 1.) Speech is a non-visual presentation. Where the selected portion is a summary section and the document includes portions other than the summary, then no other portions of the document are presented except for the overview having salient features. Accordingly, we find that Kiraly teaches step (2).

Appellants also allege that Kiraly teaches away from steps (1) and (2) because Kiraly teaches highlighting every word of an entire document until all words in *sequential* order have been highlighted. (App. Br. 17-20 and Reply Br. 4-7.) However, the claimed steps (1) and (2) do not preclude presenting sequential words of a document, provided the words provide an overview of the document. Moreover, Appellants themselves admit that an “overview” could include sequential words of a document by stating that an overview would “[f]requently, or most all of the time,” not present every

selected word in sequential order. (App. Br. 17 and 20.) Thus, we find Kiraly does not teach away from claimed steps (1) and (2).

Step (3)

Step (3) requires presenting a selected portion of a document other than the overview only if the user selected the portion. Kiraly clearly teaches that a user can select a portion of a document for presentation (FF 1) and after the selected portion is presented no other portion of the section is presented (FF 2). Appellants misconstrue Kiraly's process 400 of FIG. 4 by emphasizing automatic selection of a next section to mean that Kiraly always reads a next section independent of selection by a user. (App. Br. 19.) However, we find that Kiraly teaches automatically presenting the next section provided the next section is *within a user selected portion* and that Kiraly teaches that after the selected overview portion is presented, no other portion is presented unless the portion is *within the user selected portion*. (FF 2.) Where a user selects a non-overview portion after the user-selected overview section was presented, Kiraly teaches presenting the non-overview portion only when selected by the user. Thus, Kiraly teaches step (3).

Appellants also allege that Kiraly teaches away from step (3) because Kiraly teaches that if a user fails to select a particular document portion, the entire document will automatically be presented. (App. Br. 19 and Reply Br. 7-8.) As we discussed in the preceding paragraph, Appellants

misconstrue Kiraly; Kiraly teaches reading only a selected portion of the document. (FF 2.)

Therefore, Appellants have not shown that the Examiner erred in concluding that Kiraly teaches claim 1.

Claim 13

The Examiner finds that claim 13 is anticipated by Kiraly. (Ans. 4-6.) Appellants allege that the Examiner erred in finding claim 13 anticipated by Kiraly because Kiraly does not disclose step (1) of claim 1. (App. Br. 24.)

Therefore, for the same reasons presented with regard to step (1) *supra*, Appellants have not shown that the Examiner erred in finding that Kiraly discloses claim 13.

Other Claims

As to dependent claims 2, 4-9, 11, and 25-27, which are subject to the same rejection as claim 1, Appellants merely reference the arguments made with respect to base claim 1. (App. Br. 21 and Reply Br. 8.)

As to claims 15-17, 19, 21, 23, 33, and 34, which are subject to the same rejection as claim 13, Appellants merely reference the arguments made with respect to claim 13 (App. Br. 24-25.) As to claim 18, which depends from claim 13 but is rejected under 35 U.S.C. § 103(a), Appellants merely reference the arguments made with respect to claims 1 and 13. (App. Br. 21.)

Therefore, as to the rejection of those claims, Appellants have not shown Examiner error for the same reasons discussed *supra* with respect to claims 1 and 13.

Although Appellants reference claims 10 and 22 in the Reply Brief (Reply Br. 8), we note that Appellants do not present any argument of Examiner error for claims 10 (App. Br. 21) and 22 (App. Br. 25) despite the final rejection of those claims (Ans. 8 and 11). Therefore, as to the rejection of claims 10 and 22, the Appellants have not shown Examiner error.

NEW GROUNDS OF REJECTION

We use our authority under 37 C.F.R. § 41.50(b) to reject claim 23 under 35 U.S.C. § 101. Claim 23 recites a “computer program product in a computer readable medium for presenting content in a document.”

Appellants’ Specification provides examples of computer readable media that include wireless communications links using radio frequency and light wave forms. (Spec. 18:32 and 19:4-6.) Wave forms are not patentable. Because claim 23 includes embodiments that are wave forms, we reject claim 23 under 35 U.S.C. § 101 for failing to recite statutory subject matter.

In addition, claim 23 recites multiple instructions. We know of no authority that allows these instructions, disembodied from execution by a computer or storage on a tangible computer readable medium, to be patentable.

In addition, to the extent our affirmance of the rejections under 35 U.S.C. §§ 102 and 103 differ from the Examiner's rejections, we designate the affirmance as a new ground of rejection.

37 C.F.R. § 41.50(b)

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

CONCLUSIONS OF LAW

We conclude that:

(1) Appellants have not shown that the Examiner erred in rejecting claims 1, 2, 4-11, 18, and 25-27 under 35 U.S.C. § 103(a) for being obvious over Kiraly;

(2) Appellants have not shown that the Examiner erred in rejecting claims 13, 15-17, 19, 21-23, 33, and 34 under 35 U.S.C. § 102(e) for being anticipated by Kiraly;

(3) Claim 23 is unpatentable under 35 U.S.C. § 101 for failing to recite statutory subject matter; and

(4) Claims 1, 2, 4-11, 13, 15-19, 21-23, 25-27, 33, and 34 are not patentable.

DECISION

The Examiner's rejection of claims 1, 2, 4-11, 18, and 25-27 under 35 U.S.C. § 103(a) is affirmed.

The Examiner's rejection of claims 13, 15-17, 19, 21-23, 33, and 34 under 35 U.S.C. § 102(e) is affirmed.

New grounds of rejection have been entered under 37 C.F.R. § 41.50(b).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

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